

REMARKS

Applicant thanks the Examiner for the thorough consideration given the present application.

Claims 1-7 and 9-11 are pending. Claims 1 and 11 are independent.

Reconsideration of this application is respectfully requested.

Information Disclosure Citation

Applicant thanks the Examiner for considering the references supplied with the Information Disclosure Statement filed February 26, 2004 and for providing Applicants with an initialed copy of the PTO-1449 form filed therewith.

Claim Rejections under 35 U.S.C. §102/103

Claims 1-7, 9 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,192,236 to Irvin (hereinafter, "Irvin") in view of U.S. Patent No. 6,496,575 to Vasell et al. (hereinafter, "Vasell"). This rejection is respectfully traversed.

Irvin discloses a system that enables a radiotelephone receiving an incoming call including tone signals from a wide area cellular network to control an accessory device in the vicinity of the radiotelephone. See col. 2, lines 8-12. Irvin

only discloses using existing wireline/radio telephone infrastructure in the invention.

Contrary to what is alleged on page 3 of the Office Action, Irvin does not disclose an external communication means that includes a home page of a communication service provider through an Internet, as recited. A computerized word search of Irvin finds no disclosure of "home page." The Examiner alleges that "home page" is element 32, i.e., a radio network. Applicant respectfully disagrees. Irvin discloses that its radio network 32 may be a wire line public switched telephone network, or alternatively, it may be a radio telephone network (see col. 5, lines 56-60). Nowhere in Irvin is network 32 disclosed as a "home page," in the sense that a home page is the main page of an Internet website.

Further, with respect to claim 11, Irvin never discusses the Internet and definitely does not disclose presenting a home page accessible over the Internet. As noted above, Irvin has limited its disclosure to wireline/radio telephone networks.

The Examiner clearly admits that Irvin does not disclose (1) wherein the external communication means includes a home page of a corresponding communication service provider through an Internet, or that (2) the home page receives the operation control command from a user, as recited.

In an attempt to remedy these clearly admitted deficiencies, the Examiner turns to Vasell. However, Vasell does not disclose a "home page" either. A computerized word search of Vasell reveals that the language "home page" is not disclosed anywhere in Vasell.

Applicant also respectfully submits that the assertion that Vasell includes both features (1) and (2) is based on Vasell's disclosure from col. 6, line 45 to col. 7, line 36, from col. 9, line 62 to col. 19, line 16, and Figs. 2 and 3 is not correct.

Vasell provides a service gateway system that uses open platforms that are, preferably, operated, maintained, and supported by a business entity rather than end users or subscribers. End users may be residences, businesses or other entities (see col. 3, lines 7-34). In Fig. 2, a service gateway refers to a platform serving one end user. See col. 4, lines 39-41. Vasell's system is accessed and shared with multiple service providers and service gateway users and needs security features. See col. 4, lines 52-54.

Control for maintenance, operation and support of the service platform server 22 is preferably performed by a network operator (see col. 6, lines 9-21). A network operator associated with network operator server 24 is responsible for the operation, maintenance and support of the service platform servers of various end users. Like today's Internet service providers (ISPs) which act as intermediaries between personal computer users and the Internet, network operators using the

network operator servers 24 may act as intermediaries between service providers and the end users of those services as illustrated in Fig. 2 (see col. 6, lines 45-54). A service user may interact with implemented services by, for example, operating one of remote terminals 28 and 30 to obtain information associated with the operation of the service or change operating parameters associated with the operation of the service, e.g., monitoring results of the thermostat 12 or changing temperature settings. See col. 7, lines 21-36.

Nowhere does Vasell disclose a communication service provider having a home page. Nor does Vasell disclose a home page of a service provider receiving an operation control command from a user. As pointed out above, operational control is performed by a "network operator" which Vasell nowhere discloses as a communication service provider having a home page that receives an operation control command from a user. In Vasell, control commands are issued not by a user but by a "network operator."

Accordingly, even if these two references, i.e., Irvin and Vasell were somehow properly combined (and they are not properly combined for reasons discussed below) they would not result in a combination that would meet or render obvious the claimed invention.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In

re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not

make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Also, the factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness should be made, including the differences between the references themselves and between the references and the claimed invention.

However, these inquiries are not found in the Office Action with respect to independent Claim 1.

The Examiner concludes that it would be obvious to "have a mobile phone controlling and monitoring plurality of home appliances through an Internet of Vasell et al. in cellular telephone receives control commands over a wide area cellular network utilizing a remote control adaptor of Irvin with the motivation for

doing so would have been to expand controlling and monitoring plurality of home appliances remotely from a mobile phone via an Internet to increase flexibility.”

Applicant respectfully submits that the Examiner fails to meet the burden of demonstrating proper motivation for one of ordinary skill in the art to modify Irvin in view of Vasell as proposed.

First, the Examiner does not address the fact that Irvin and Vasell are set up to function differently. Irvin’s disclosure is limited to telephone use, either wire line or radio telephone use. Irvin deliberately discloses its desire to utilize existing high quality radiotelephones whose cost has been previously absorbed to obtain voice service for users, as receivers, to provide high quality long-range remote control capabilities at a favorable cost without incurring additional costs associated with access to a transmission network for the remote control functions. (see col. 2, lines 16-30). Moreover, as stated in the last sentence of the Abstract in Irvin, a user’s radiotelephone may be converted on an as needed basis to operate as a receiver for remote control of accessory devices and readily return to normal use as a radiotelephone when remote control is no longer required.

Vasell, on the other hand, is directed to open and horizontal platform information and communication systems used to distribute and operate connectivity based services. To this end, Vasell provides an internet 26 and a

network operator server 24 and a service platform server 22 between a client 28 or 30 and accessory devices.

Irvin does not need (or want – see below) Vasell's internet 26 or network operator server 24 or a service platform server 22 to operate properly and effectively and at relatively low cost.

In other words, there is no need to add the open, horizontal service platforms of Vasell to Irvin to get Irvin to work effectively as an "as needed" remote control system. Moreover, Irvin does not want the additional network features of Vasell and teaches away from being modified as suggested because Irvin explicitly indicates that it does not want to incur additional costs associated with access to a transmission network for remote control functions (see col. 2, lines 16-30).

Second, the assertion on page 4 of the Office Action that one of ordinary skill in the art recognizes the need to have a mobile phone controlling and monitoring and controlling a plurality of home appliances through an Internet of Vasell is not based on objective evidence of record, but on improper speculation, especially considering the fact that adding an Internet connection would fly in the face of Irvin's explicit teaching against incurring additional costs associated with access to a transmission network.

Accordingly, the Examiner has not provided objective evidence that one of ordinary skill in the art would desire to modify Irvin's "as needed" radiotelephone

remote control system into a system that would involve use of a transmission network such as an internet or the Internet, thereby incurring additional costs.

The mere fact that these two references may be combined in some way does not make the modification obvious unless the prior art suggests the desirability of the modification.

Moreover, the broad, conclusory speculative statement that Irvin and Vasell are “in the same field of endeavor,” standing alone, is not proper evidence of motivation to modify Irvin in view of Vasell, as suggested. Compare, In re Dembiczak, cited above, in this regard.

Accordingly, Applicant respectfully submits that the Examiner fails to make out a *prima facie* case of proper incentive for one of ordinary skill in the art to modify Irvin in view of Vasell as suggested to achieve the claimed invention.

Moreover, the proposed modification of Irvin in view of Vasell would not provide an apparatus and method which allows monitoring and control of the appliance network in a more simplified manner and at a greatly reduced cost. See page 4, lines 5 and 13 of Applicant’s specification.

Furthermore, as noted above, even if these references were properly combined, which they are not, the resulting reference combination would not result in or render obvious the claimed invention.

Accordingly, the Examiner does not make out a *prima facie* case of obviousness of the claimed invention.

For at least the foregoing reasons, independent claims 1 and 11 and their dependent claims under rejection are patentable over the applied prior art. Reconsideration and withdrawal of the rejection of claims 1-7, 9 and 11 are respectfully requested.

Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Irvin in view of Vasell, and further in view of U.S. Patent No. 6,061,604 to Russ et al. (hereinafter, "Russ"). This rejection is respectfully traversed.

Initially, Applicants note that claim 10 depends from 11 and recites all the features recited in claim 11. Because claim 11 is not rendered obvious by Irvin and Vasell, for reasons stated above, and because Russ is not applied to provide the deficiencies in the Irvin-Vasell reference combination, claim 10 is not obvious in view of the aforementioned reference combination of Irvin, Vasell and Russ.

In other words, even if Russ were used to provide an error output feature to Irvin or Vasell, the resulting reference combination would still not constitute or render obvious the claimed invention for the reasons stated above regarding the deficiencies of the improperly combined Irvin-Vasell reference combination.

Accordingly, this rejection of claim 10 is improper, and reconsideration and withdrawal of this rejection of claim 10 are respectfully requested.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Reg. No. 46,472, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

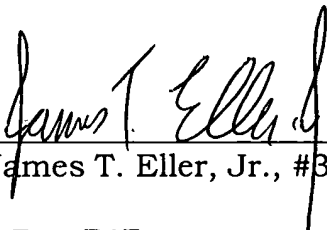
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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